

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Jingwei Tan et al.  
Serial No. : 10/540,190  
Confirmation No. : 1171  
Filing Date : June 20, 2005  
Group Art Unit : 2178  
Examiner : Kyle R. Stork  
Attorney Docket No. : NL021475

**APPEAL BRIEF  
On Appeal from Group Art Unit 2178**

Date: May 21, 2008

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## **I. REAL PARTY IN INTEREST**

The real party in interest is Koninklijke Philips Electronics N.V., the assignee of record.

## **II. RELATED APPEALS AND INTERFERENCES**

Appellant is not aware of any pending appeals, judicial proceedings, or interferences which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS**

- a) Claims 1-6 are pending at the time of filing the appeal brief.
- b) Claims 1 and 4 are independent.
- c) Claims 1-6 stand rejected and are the subject of this appeal.

## **IV. STATUS OF AMENDMENTS**

The claims listed in section "VIII. Claims Appendix" of this Appeal Brief correspond to the claims as submitted in Appellant's amendment filed November 9, 2007. No claim amendments have been submitted following the amendment of November 9, 2007. These claim amendments were entered by the Examiner as indicated in the final Office Action of December 27, 2007.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed invention, as recited in claim 1, is directed to a method (Fig. 2, S100; page 2, line 22 to page 3, line 18; page 4, lines 21-25) of operating a recording device (Fig. 1, 10), said method comprising: storing a recording (Fig. 2, S102; page 2, lines 22-26) on a removable recording medium (Fig. 1, 70); adding interactivity (Fig. 2, S104; page 2, line 27 to page 3, line 6) to the recording; and linking the recording (Fig. 2, S106; page 3, lines 9-18) and an interactive module (Fig. 1, 72) based on the interactivity added to the recording (Fig. 1, 71).

The claimed invention, as recited in claim 4, is directed to a recording device (Fig. 1, 10; page 2, lines 12-21; page 4, lines 1-20), comprising; means for storing (Fig. 1, 41; page 2, lines 12-21; page 4, lines 1-20) a recording (Fig. 1, 71) on a removable recording medium (Fig. 1, 70); means for adding interactivity (Fig. 1, 42; page 2, lines 12-21; page 4, lines 1-20) to the recording; and means for linking (Fig. 1, 41; page 2, lines 12-21; page 4, lines 1-20) the recording (Fig. 1, 71) and the interactive module (Fig. 1, 72) based on the interactivity added to the recording.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 1-6 are properly rejected under 35 U.S.C. 102(b) as being anticipated by Wistendahl et al. (USP 5,798,845, hereinafter Wistendahl).

## **VII. ARGUMENT**

Appellant respectfully traverses the rejections in accordance with the detailed arguments set forth below.

### **A. Claims 1-6 are not properly rejected under 35 U.S.C. 102(b) as being taught by Wistendahl.**

In order for a reference to anticipate a claim the MPEP 2131 requires the reference to teach each and every element of that claim. It is respectfully submitted that the Examiner failed to establish a prima facie case of anticipation.

#### **1. Claim 1**

Appellant's claim 1 includes the features of: "adding interactivity to the recording" and "linking the recording and an interactive module based on the interactivity added to the recording."

In contrast to Appellant's claimed feature, Wistendahl teaches that an N data file is maintained separately from the Frame Data (Abstract). The N data file contains the coordinates and frame addresses of "hot spots" of a recording and stores them as data in the N data file. The N data file is physically or logically separate from the media content (col. 4, line 60 to col. 5, line 8). In fact, Wistendahl teaches keeping the recording intact. There is no adding interactivity to the recording described in the reference Wistendahl. Any interactivity is provided separately from any recording.

In Wistendahl, in order to perform the functions associated with "hot spots," the subscriber terminal must run an IDM (interactive digital media) program in conjunction with the display of the movie (col. 3, lines 24-38). "The IDM program has established linkages

connecting the objects mapped by the N data to other functions to be performed in conjunction with display of the media content” (Abstract) (emphasis added).

Wistendahl does not describe adding interactivity to the recording, but creates an N data file which works with the IDM program.

Furthermore, there is no teaching of “linking the recording and an interactive module based on the interactivity added to the recording” (emphasis added) as in Appellant’s claim 1.

In Wistendahl the N data file is linked with the IDM and the original recording is left intact. There is no teaching in Wistendahl of adding interactivity to a recording, therefore, there can be no linking of the recording based on the interactivity added to the recording, because in Wistendahl the N data file is a separate module from the recording and nowhere does Wistendahl teach linking the recording to either the N data file or the IDM. As pointed out above, the Abstract in Wistendahl describes: “The IDM program has established linkages connecting the objects mapped by the N data to other functions to be performed in conjunction with display of the media content.”

In the “Response to Arguments” section of the final Office Action the Examiner points to col. 9, lines 17-33 of Wistendahl as teaching the “*providing* interactivity to a recording.” Appellant notes that “*providing*” interactivity to a recording is different from the claimed feature of adding interactivity to the recording. Furthermore, in this section Wistendahl again makes clear that an IDM program is used to look for the “hot spots” or objects appearing in original media content. Wistendahl, col. 9, lines 36-44 teaches that the linking information or shape data that the IDM program uses to look for hot spots in the original content is stored as a separate file. This is clearly described in col. 3, lines 38-47 of Wistendahl.

Wistendahl, col. 9, lines 50-58 again describes that the display coordinate addresses for the pixel elements of the outlined shape can be stored in a separate file as object mapping data. For example, the N data file contains the coordinates and frame addresses of the “hot spots” of the recording and stores them as data in the N data file, as discussed above.

The Examiner also points to col. 3, lines 1-23 of Wistendahl. However, col. 3, lines 9-14 describes that the N data file is linked to other functions. There is no suggestion of “adding interactivity to the recording” and “linking the recording and an interactive module based on the interactivity added to the recording” (emphasis added).

Thus, Wistendahl fails to teach or even suggest each and every claimed feature recited in Appellant’s claim 1, therefore, a prima facie case of anticipation has not been presented. Accordingly, Appellant respectfully submits that the rejection of claim 1 should be reversed.

## **2. Claims 2-3**

Claims 2-3 depend upon claim 1 and are allowable at least by virtue of their dependency therefrom and because they recites further distinguishing features. Appellant essentially repeats the above arguments from claim 1.

For at least the foregoing reasons, Wistendahl fails to teach or even suggest each and every feature recited in Appellant’s claims 2-3, therefore, a prima facie case of anticipation has not been presented and the rejection should be reversed.

## **3. Claim 4**

Appellant’s independent claim 4 is directed to a recording device including: “means for adding interactivity to the recording; and means for linking the recording and the interactive module based on the interactivity added to the recording.”

In rejecting claim 4 the Office Action points to the arguments utilized in rejecting claim 1. Accordingly, Appellant essentially repeats the above arguments from claim 1 pointing out why Wistendahl fails to teach at least the above mentioned features of claim 4. Because Wistendahl fails to teach or even suggest each and every feature recited in Appellant's claim 4, a prima facie case of anticipation has not been presented and the rejection should be reversed.

#### **4. Claims 5 and 6**

Claims 5 and 6 depend from claim 4 and include all the limitations of claim 4 and further distinguishing features. Accordingly, Appellant essentially repeats the above arguments from claim 4 (claim 1) and respectfully submits that claims 5 and 6 are allowable by virtue of their dependency, as well as the additional subject matter recited therein and not shown in Wistendahl, thus the rejection should be reversed.

#### **CONCLUSION**

In light of the above, Appellant respectfully submits that the rejection of claims 1-6 is in error, legally and factually, and must be reversed.

Respectfully submitted,

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## **VIII. CLAIMS APPENDIX**

- 1.(previously presented)      A method of operating a recording device, said method comprising:
  - storing a recording on a removable recording medium;
  - adding interactivity to the recording; and
  - linking the recording and an interactive module based on the interactivity added to the recording.
- 2.(previously presented)      The method of claim 1, further comprising:
  - storing the interactive module on the removable recording medium, the interactive module corresponding to the interactivity added to the recording.
- 3.(previously presented)      The method of claim 1, further comprising:
  - storing an interactive link on the removable recording medium, the interactive link representative of the linking of the recording and the interactive module.
- 4.(previously presented)      A recording device, comprising;
  - means for storing a recording on a removable recording medium;
  - means for adding interactivity to the recording; and
  - means for linking the recording and the interactive module based on the interactivity added to the recording.
- 5.(previously presented)      The recording device of claim 4, further comprising:
  - means for storing the interactive module on the removable recording medium, the interactive module corresponding to the interactivity added to the recording.
- 6.(previously presented)      The recording device of claim 4, further comprising:
  - means for storing an interactive link on the removable recording medium, the interactive link representative of the linking of the recording and the interactive module.

**IX. EVIDENCE APPENDIX**

No evidence has been submitted pursuant to §§ **1.130**, **1.131**, or **1.132** of this title nor any other evidence entered by the examiner and relied upon by appellant in the appeal.

**X. RELATED PROCEEDINGS APPENDIX**

Appellant is not aware of any appeals or interferences related to the present application.